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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/881,360

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Steven E. Norby

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12/03/2004

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EXAMINER

NG, CHRISTINE Y

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/881,360

Applicant(s)

NORBY, STEVEN E.

Examiner

Christine Ng

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 4, 10 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/17/01, 1/30/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 5-9, 11-15, 17, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,181,940 to Rune.

Referring to claim 1, Rune discloses in Figure 4 a method for establishing a personal communication (location area registration scheme, communications protocol or communications standard) between an originating end (mobile terminal) and a terminating end (network) of a communication system. Refer to Column 3, lines 9-15; Column 9, lines 31-59 and Abstract. The method comprises steps of (applied to a location area registration scheme):

Retrieving a first plurality of personal communication modes (location area registration schemes) associated with the originating end (mobile terminal). Refer to Column 3, lines 58-62.

Selecting one of the first plurality of personal communication modes (location area registration schemes), wherein the selecting step comprises:

Determining if a second plurality of personal communication modes (location area registration schemes) associated with the terminating end (network) comprises any personal communication modes (location area registration schemes) compatible with the first plurality of personal communication modes (location area registration schemes). Refer to Column 3, line 62 to Column 4, line 7.

Automatically choosing a compatible personal communication mode (location area registration scheme) from the first plurality of personal communication modes (location area registration schemes) and the second plurality of personal communication modes (location area registration schemes). Refer to Column 3, line 62 to Column 4, line 7.

Indicating the compatible personal communication mode (location area registration scheme) to the terminating end (network). Refer to Column 3, line 62 to Column 4, line 7.

Referring to claim 2, Wood discloses that the method further comprises the steps of:

Receiving the first plurality of personal communication modes (location area registration schemes) from a first user (mobile terminal user) associated with the originating end (mobile terminal). Refer to Column 3, lines 58-62.

Receiving the second plurality of personal communication modes (location area registration schemes) from a second user (network user) associated with the terminating end (network). Refer to Column 3, lines 62-65.

Referring to claim 3, Rune discloses that the compatible personal communication mode (location area registration scheme) couples communication between individuals. Refer to Column 3, line 62 to Column 4, line 7.

Referring to claim 5, Rune discloses that the first plurality of compatible personal communication modes (location area registration schemes) are stored in a database that is proximate to the originating end (mobile terminal). Mobile terminals hold numbers corresponding to location area registration schemes that it can use. Refer to Column 3, lines 58-62.

Referring to claim 6, Wood discloses in Figures 1 and 4 that the automatically choosing step is based, at least in part, upon input received from one of an originating end (mobile terminal) and a terminating end (network). Refer to Column 3, line 58 to Column 4, line 7.

Referring to claim 7, Rune discloses in Figure 4 a method for automatically selecting a compatible personal communication mode (location area registration scheme, communications protocol or communications standard) between an originating end (mobile station) and terminating end (network) of a communication system. Refer to Column 3, lines 9-15; Column 9, lines 31-59 and Abstract. The method comprises the steps of (applied to a location area registration scheme):

Receiving a first plurality of personal communication modes (location area registration schemes) associated with a originating end (mobile stations). Refer to Column 3, lines 58-62.

Receiving a second plurality of personal communication modes (location area registration schemes) associated with a terminating end (network). Refer to Column 3, lines 62-65.

Initiating (Steps S30-S40) a first personal communication between the originating end (mobile terminal) and terminating end (network). Refer to Column 7, lines 37-44.

Selecting (Steps S50-S60) the compatible personal communication mode (location area registration scheme) based upon the first plurality of personal communication modes (location area registration schemes) and the second plurality of personal communication modes (location area registration schemes). Refer to Column 7, lines 45-51 and Column 8, lines 6-28.

Initiating (Steps S40) a second personal communication using the compatible personal communication mode (location area registration scheme). Refer to Column 7, lines 52-54.

Referring to claim 8, Rune discloses in Figure 4 that the method further comprises the step of determining that a first personal communication mode (location area registration scheme) for the first personal communication is unavailable. The terminal and network "continue to utilize the negotiated location area registration scheme until the terminal moves into a portion of the network in which the prevailing scheme is no longer appropriate" (Column 7, lines 46-49).

Referring to claim 9, Rune discloses that the selecting step comprises steps of negotiating the compatible personal communication mode with a first decision tree (set of available schemes 0 to N-1) associated with the originating end (mobile terminal) and

a second decision tree (set of available schemes 0 to N-1) associated with the terminating end (network). Refer to Column 3, lines 9-15 and Column 3, line 58 to Column 4, line 7.

Referring to claim 11, refer to the rejection of claim 3.

Referring to claim 12, refer to the rejection of claim 5.

Referring to claim 13, Rune discloses in Figure 4 a personal communication system for establishing personal communication (location area registration scheme, communications protocol or communications standard) between a originating end (mobile terminal) and a terminating end (network). Refer to Column 3, lines 9-15; Column 9, lines 31-59 and Abstract. The personal communication system comprises (applied to a location area registration scheme):

A first plurality of personal communication modes (location area registration schemes) associated with the originating end (mobile terminals). Refer to Column 3, lines 58-62.

A second plurality of personal communication modes (location area registration schemes) associated with the terminating end (network). Refer to Column 3, lines 62-65.

A first personal communication mode (Steps S30-S40) that couples the originating end (mobile terminal) and the terminating end together (network). Refer to Column 7, lines, 37-44.

A decision mechanism (Steps S50-S60) for automatically choosing a second personal communication mode that is compatible with at least one of mode in each of

the first plurality of personal communication modes (location area registration schemes) and the second plurality of personal communication modes (location area registration schemes). Refer to Column 7, lines 45-51 and Column 8, lines 6-28.

Referring to claim 14, Rune discloses in Figure 4 that a determination is made that the first personal communication mode (location area registration scheme) is unavailable before the decision mechanism chooses the second personal communication mode (location area registration scheme). The terminal and network "continue to utilize the negotiated location area registration scheme until the terminal moves into a portion of the network in which the prevailing scheme is no longer appropriate" (Column 7, lines 46-49).

Referring to claim 15, Rune discloses in Figure 4 that the decision mechanism is in the terminating end (network). The "terminal and the network renegotiate for a new best, mutually agreeable scheme and thereafter use the newly negotiated scheme to track movement of the terminal" (Column 7, lines 52-54).

Referring to claim 17, Rune discloses in Figure 4 that the first plurality of personal communication modes (location area registration schemes) is sent (Steps S30-S40) from originating end (mobile terminal) to the terminating end (network) using the first personal communication mode. Refer to Column 7, lines 37-44.

Referring to claim 18, Rune discloses that the second personal communication mode is different from the first personal communication mode. A new location area registration scheme is chosen when the terminal moves "where the network no longer supports the prevailing scheme or supports a scheme which is



superior to the prevailing scheme and which the terminal also supports" (Column 7, lines 49-51).

Referring to claim 20, refer to the rejection of claim 5.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,181,940 to Rune in view of U.S. Publication No. 2002/0018487 to Chen et al.

Rune discloses that the user associated with the originating end (mobile terminal) negotiates a new communication (location area registration scheme, communications protocol or communications standard) in response to the first communication mode being unavailable. Refer to Column 8, lines 6-21.

Rune does not disclose a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable.

Chen et al discloses in Figure 2 a mobile station 205 that includes an application programming interface API 210 that allows "a programmer to change the communication protocol used by an apparatus by selecting an option in a simple menu of options" (Section 0017) in order to "provide timely and efficient adaptation to meet the

ever-changing needs of the wireless communication field" (Section 0009). Refer to Section 0040. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable, the motivation being so that the wireless system can be more flexible and adaptable by accommodating a variety of communication protocols each with its own unique system requirements and allowing the mobile station to be used in different environments as it moves from one location to another. Refer to Sections 0003-0011.

***Allowable Subject Matter***

5. Claims 4, 10 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

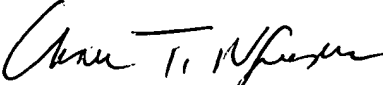
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (571) 272-3124. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Ng *cn*  
November 29, 2004

  
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